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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,750	03/30/2004	Jurgen Dannenmaier	GAMBRO 3.3-254 CONT	4500

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EXAMINER
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MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/813,750

**Applicant(s)**

DANNENMAIER ET AL

**Examiner**

Krishnan S Menon

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

Claims 1-14 are pending

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as unpatentable over Oscarsson (US 4,341,005).

Claim 1: Oscarsson teaches a method for producing a hollow fiber filter having a housing with first and second portion (10a, 10b-fig 1), laying the plurality of fibers in the first portion (fig 1), forming the filter housing from the first and second portion (col 2 lines 54-62), connecting the plurality of fibers together on at least one end and with the housing by applying a potting compound (col 3 lines 14-32), subsequently cutting the ends of the hollow fibers at least at one end of the housing to have open ends for the fibers (col 3 lines 14-37). With regard to the 'connecting said plurality of hollow fibers together and to said filter housing and *simultaneously* sealing the said first and second portions ... by applying a potting compound thereto ...', the reference teaches sealing the seams before or after it is taken off the wheel in col 3 lines 54-62; and 'potting' to

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seal the ends of the fibers between themselves and the two halves of the housing, as claimed, in col 3 lines 14-31.

Since the potting seals the fibers and the portions of the housing together, it inherently seals the two portions together at least at the ends, which satisfies the claim language as recited (giving the broadest reasonable interpretation). However, the reference does not specifically teach simultaneously sealing *the entire length* of the first and second portions together along with potting of the ends of the fibers, if the claim so implies. If the claim is so interpreted, then selecting or changing the order of a process step is considered as prima facie obvious, because Oscarsson teaches sealing the two portions together in col 2 lines 54-63. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

Claim 2: sealing the terminal portions of the fibers to cover the ends of the fibers (col 3 lines 14-37)

Claim 3: rotary winding wheel – see fig 1.

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Claim 4: severing the hollow fibers after sealing the first and second portions of the housing – col 2 lines 54-62

Claim 7: first and second portion of the housing are half-shell – see figures.

Claim 8: sealing method is gluing – as discussed in rejection of claims 1 and 2.

Claim 9: the first and second portion of the housing are clamped together prior to sealing – see col 2 lines 54-62, col 3 lines 14-32.

2. Claims 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Oscarsson (US 4,341,005).

Claim 10: Oscarsson teaches a hollow fiber membrane tubular filter comprising a filter housing having first and second portion of half-shell shapes, bundle of hollow fibers disposed in the housing, ends of the bundle potted with the housing – see figures 1-3

Claim 14: the potting aperture recited in this claim is a part required for the process of making the filter, and is not a structural part in the finish product. In any case, such an aperture is shown in fig 2 at 23.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 5,6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oscarsson (005) in view of Baurmeister et al (US 4,724,900).

Claim 5 and 6: Oscarsson teaches a method for producing a hollow fiber filter having a housing with first and second portion (10a, 10b-fig 1), laying the plurality of fibers in the first portion (fig 1), forming the filter housing from the first and second portion (col 2 lines 54-62), connecting the plurality of fibers together on at least one end and with the housing by applying a potting compound (col 3 lines 14-32), subsequently cutting the ends of the hollow fibers at least at one end of the housing to have open ends for the fibers (col 3 lines 14-37) as in claim 1. Claims 5 and 6 add the further process limitation of flexible connecting the two halves of the housing and swinging the first and second portions, which is not taught by Oscarsson. Baurmeister teaches the flexible film hinge which would make the two halves swing – see figure 4. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Baurmeister in the teaching of Oscarsson to make the housing assembly easier and for automation as taught by Baurmeister (col 3 lines 1-20).

Claims 11-13: Oscarsson teaches a hollow fiber membrane tubular filter comprising a filter housing having first and second portion of half-shell shapes, bundle of hollow fibers disposed in the housing, ends of the bundle potted with the housing – see figures 1-3 as in claim 10. Claims 11-13 similarly recite flexible connectors which are film hinges for the product, which are taught by Baurmeister. Claim 13 also recite clamping, which is taught by Baurmeister – see 14 in fig 15. It may also please be noted that the flexible connectors and the clamping in the housing are only parts that

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are active in the assembly process, and not a structural or functional component of the finished product. ("[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re *Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)).

### ***Response to Arguments***

Applicant's arguments filed 9/17/04 have been fully considered but they are not persuasive.

Applicants' arguments re the *Celeritas* case is moot, since it is not required in the rejection any more.

In response to the arguments re the simultaneous sealing of the two portions of the housing along with the potting of the fibers (the alleged main difference from the *Oscarsson* ref), please see the rejection.

In response to the arguments against the *Baurmeister* ref: fig 14 of *Baurmeister* teaches flexible joints in the shell, albeit more than one, which is like a film hinge (the flexible joint, or the thinned portion is like a film hinge). This joint also makes the housing in a single piece. The claims are open ended, and thus do not limit to just one hinge or just two portions. Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the

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primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is clearly stated in the rejection, which is that Baurmeister teaches this method of assembly for process automation.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon  
Patent Examiner

  
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